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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/066,582 | 02/06/2002 | Jurgen Hoffmann | 016790-0455 | 5464 |
| 22428 | 7590 | 08/18/2004 | EXAMINER | |
| FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007 | | | LUU, THANH X | |
| | | ART UNIT | PAPER NUMBER | |
| | | | 2878 | |

DATE MAILED: 08/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------|------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/066,582 | HOFFMAN, JUERGEN | |
| | Examiner Thanh X Luu | Art Unit 2878 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 10 June 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-3,7-10,12,14 and 16-27 is/are pending in the application.

4a) Of the above claim(s) 16,23-25 and 27 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-3,7-9,12,14,17,18,21,22 and 26 is/are rejected.

7) Claim(s) 10 and 20 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) Interview Summary (PTO-413) Paper No(s) _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of claims 1-3, 7-10, 12, 14, 17-22 and 26 in Paper No. 062004 is acknowledged. The traversal is on the ground(s) that the search is not burdensome on the Examiner since an action on the merits has been conducted already. This is not found persuasive because Applicant's subsequent amendment has changed the scope of the claims to more clearly define the distinct species. Since a separate search would have to be conducted on each species, there is a burden on the examiner. Thus, the requirement is still deemed proper and is therefore made FINAL.

Claims 1-3, 7-10, 12, 14, 16-26 and 27 are currently pending. Claims 16, 23-25 and 27 are withdrawn.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 7, 9, 12, 14, 17, 18 and 26, are rejected under 35 U.S.C. 102(b) as being anticipated by Kashima et al. (U.S. Patent 6,094,300).

Regarding claims 1-3, 7, 9, 12, 14, 17, 18 and 26, Kashima et al. disclose (see Figs. 1 or 2) a scanning microscope system, comprising: a scanning microscope comprising: a light source (100, 2) that emits an exciting light beam which is suitable for exciting an energy state in a specimen and that emits a stimulating light beam configured for generating stimulating emission in the specimen, whereby the exciting light beam and the stimulating light beam overlap in a focal region (at 110) at least partially; and at least one detector (115) configured for detection of emitted light proceeding from the specimen; and a module (102 or 4) that is positionable in a beam path of the scanning microscope and that comprises multiple optical elements (102a, 102b; or 4a, 4b), pre-aligned with respect to each other, which shape the stimulating light beam, and wherein the module is adjustable (elements scanned) with respect to the scanning microscope. Kashima et al. also disclose (see Figs. 1 or 2) the module comprises a housing (102 or 4); the module's perimeter inherently acts as an alignment device as claimed; the module comprises optics for spreading (scanning mirrors) or influencing the shape of the focus of the stimulating light beam.

5. Claims 1-3, 7, 9, 12, 14, 17, 18 and 26, are rejected under 35 U.S.C. 102(e) as being anticipated by Dorsel et al. (U.S. Patent 6,320,196).

Regarding claims 1-3, 7, 9, 12, 14, 17, 18 and 26, Dorsel et al. disclose (see Fig. 1) a scanning microscope system, comprising: a scanning microscope comprising: a light source (35, 40) that emits an exciting light beam which is suitable for exciting an

energy state in a specimen and that emits a stimulating light beam configured for generating stimulating emission in the specimen, whereby the exciting light beam and the stimulating light beam overlap in a focal region (at 55) at least partially; and at least one detector (90, 95) configured for detection of emitted light proceeding from the specimen; and a module (66) that is positionable in a beam path of the scanning microscope and that comprises multiple optical elements (60, 65), pre-aligned with respect to each other, which shape the stimulating light beam, and wherein the module is adjustable (see arrows in Fig. 1) with respect to the scanning microscope. Dorsel et al. also disclose (see Fig. 1) the module comprises a housing; the module's perimeter inherently acts as an alignment device as claimed; the module comprises optics for focusing (65) or influencing the shape of the focus of the stimulating light beam.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 8, 19, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Kashima et al. or Dorsel et al.

Regarding claims 8, 19 and 22, Kashima et al. and Dorsel et al. disclose the claimed invention as set forth above. Kashima et al. and Dorsel et al. do not specifically disclose a retardation plate. However, retardation plates are notoriously well known in the art to adjust the polarization of a beam as desired. It would have been obvious to a

person of ordinary skill in the art at the time the invention was made to provide a retardation plate in the apparatus of Kashima et al. or Dorsel et al. to obtain a specific polarization of an input beam for improved detection.

Regarding claim 21, Kashima et al. and Dorsel et al. disclose the claimed invention as set forth above. Kashima et al. and Dorsel et al. do not specifically disclose a liquid crystal array as claimed. However, it is well known that liquid crystal arrays provide adjustable degrees retardation. Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made use a liquid crystal array in the apparatus of Kashima et al. or Dorsel et al. to obtain more configurable retardation.

Allowable Subject Matter

8. Claims 10 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

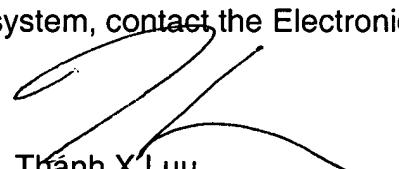
10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire

THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh X Luu whose telephone number is (571) 272-2441. The examiner can normally be reached on M-F (6:30-4:00) First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Porta can be reached on (571) 272-2444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thanh X Luu
Primary Examiner
Art Unit 2878